

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference PC 05 079 M	FOR FURTHER ACTION		See item 4 below
International application No. PCT/EP2005/003594	International filing date (day/month/year) 06 April 2005 (06.04.2005)	Priority date (day/month/year) 13 May 2004 (13.05.2004)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant OSYPKA, Peter			

- This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).
- This REPORT consists of a total of 9 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

- This report contains indications relating to the following items:

- | | |
|--|---|
| <input checked="" type="checkbox"/> Box No. I | Basis of the report ✓ |
| <input type="checkbox"/> Box No. II | Priority |
| <input type="checkbox"/> Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input checked="" type="checkbox"/> Box No. IV | Lack of unity of invention ✓ |
| <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement ✓ |
| <input type="checkbox"/> Box No. VI | Certain documents cited |
| <input type="checkbox"/> Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> Box No. VIII | Certain observations on the international application |

- The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis.2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 30, Switzerland Facsimile No. +41 22 338 82 70	Date of issuance of this report 04 December 2006 (04.12.2006)
	Authorized officer Yolaine Cussac e-mail: pt11@wipo.int

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:

PCT

TRANSLATION

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Applicant's or agent's file reference PC 05 079 M ✓		Date of mailing (day/month/year)	See form PCT/ISA/210
		FOR FURTHER ACTION See paragraph 2 below	
International application No. PCT/EP2005/003594 ✓	International filing date (day/month/year) 06.04.2005 ✓	Priority date (day/month/year) 13.05.2004 ✓	
International Patent Classification (IPC) or both national classification and IPC A61B5/00			
Applicant OSYPKA, Peter ✓			

1. This opinion contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|--|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the opinion ✓ |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input checked="" type="checkbox"/> | Box No. IV | Lack of unity of invention ✓ |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement ✓ |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 60.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP	Authorized officer
Facsimile No.	Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2005/003594

Box No. I

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2005/003594

Box No. IV

Lack of unity of invention

1. ☒ In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has:
- ☐ paid additional fees
- ☐ paid additional fees under protest
- ☒ not paid additional fees ✓
2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention is accordance with Rules 13.1, 13.2 and 13.3 is
- ☐ complied with
- ☒ not complied with for the following reasons: ✓
4. Consequently, this opinion has been established in respect of the following parts of the international application:
- ☐ all parts
- ☒ the parts relating to claims Nos. 1-22 ✓

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2005/003594

Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims		YES
	Claims	1-22	NO
Inventive step (IS)	Claims		YES
	Claims	1-22	NO
Industrial applicability (IA)	Claims	1-22	YES
	Claims		NO
2. Citations and explanations:			
1 INDEPENDENT CLAIM 1			
1.1 The present application does not meet the requirements of PCT Article 33(1) because the subject matter of claim 1 is not novel within the meaning of PCT Article 33(2) .			
D1 discloses (the references in parentheses are to this document):			
<p>A measuring device for detecting medical parameters in the human body which can be accommodated in a body cavity, more particularly a blood vessel (paragraphs 11 and 21), with at least one sensor (paragraph 11, lines 3-4) and a retaining device (paragraph 5), wherein the retaining device has at least a first (figure 1b, 115) and a second (figure 1, 102, and paragraph 23) magnetic element, at least one of which is a magnet (claim 3) and of which one is arranged inside and one outside the body cavity (figure 1), and the measuring device can be fixed in the body cavity by the retaining device (paragraph 5 and</p>			

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2005/003594

Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

claim 8: "... the system is used for locating and/or positioning a device *in vivo*", that is, the measuring device can also be retained or fixed in a position).

Therefore, the subject matter of claim 1 is not novel (PCT Article 33(2)).

2 DEPENDENT CLAIMS

- 2.1 The features of dependent claims 2-22 are either known from D1-D6 or concern minor structural modifications of the kind that a person skilled in the art routinely makes on the basis of familiar considerations. Consequently, dependent **claims 2-22** do not meet the PCT requirements for **novelty and inventive step (PCT Article 33(2) and (3))**.

For example, in re claim 2, see D1, claim 3; in re claims 3 and 5, see D2, paragraph 96; in re claim 4, see D1, paragraph 25; in re claim 6, see D1, paragraph 5; in re claim 7, see D1, paragraph 25; in re claim 8, see D1, paragraph 21; in re claim 9, see D1, figure 1; in re claim 12, see D3, paragraph 86; in re claims 13 and 14, see D4, claims 1-4; in re claim 15, see D1, paragraph 25; in re claims 19 and 20, see D3, paragraphs 74 and 75; in re claims 16-18, see D5, paragraphs 13, 14 and 16 and claims 10 and 24; in re claims 19 and 21, see D2, paragraphs 107 and 108.

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of:

Box IV

- 1 This report makes reference to the following documents:

D1: US 2003/114742 A1 (LEWKOWICZ SHLOMO ET AL)
19 June 2003 (2003-06-19)
D2: US 2004/082850 A1 (BONNER MATTHEW D ET AL)
29 April 2004 (2004-04-29)
D3: US 2003/181788 A1 (YOKOI TAKESHI ET AL)
25 September 2003 (2003-09-25)
D4: WO 98/43700 A (ALFRED E. MANN FOUNDATION FOR
SCIENTIFIC RESEARCH; SCHULMAN, JOSEPH, H)
8 October 1998 (1998-10-08)
D5: US 2004/050394 A1 (JIN SUNGHO) 18 March 2004
(2004-03-18)
D6: WO 02/082979 A (BBMS LTD; HAREL, ALEX; DAN,
UZI; KATZNELSON, EHUD; RAVIV, ZVI)
24 October 2002 (2002-10-24)

- 2 This Authority has established that the present international application contains multiple (groups of) inventions which are not linked by a single general inventive concept (PCT Rule 13.1), as follows:

I: Claims 1-22 relate to structural features and/or optional therapeutic or diagnostic appliances of an *in vivo* measuring device with two magnetic elements.

Supplemental Box

II: Claims 23-25 relate to an *in vivo* measuring device which can be used in combination with an additional implant.

- 2.1 D1 is considered to be prior art relevant to evaluating unity of invention. D1 discloses all the features of claim 1 (see below), to which all the dependent claims refer back. Comparison of the present groups of inventions with D1 reveals the following:

Group I: D1 discloses all the features of claims 1-15 (see below). The subject matter of claims 16-18 and that of D1 differ *inter alia* in that a storage device for accommodating a drug is provided on the measuring device (claim 16). The problem addressed may be seen to consist in extending the range of application of an intracorporeal device such that therapeutic measures can also be spontaneously carried out in conjunction with an intracorporeal physical measurement.

Group II: These claims differ from D1 in that the measuring device is arranged on a stent cage. The problem addressed may be seen to consist in combining implantation of a blood vessel-dilating or stabilizing element (in any case required) with that of a suitable measuring device at an appropriate site.

- 2.2 Since the special technical features (storage device and stent cage) indicated above are neither

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2005/003594

Supplemental Box

the same nor corresponding features, no technical relationship among the two groups of inventions within the meaning of PCT Rule 13.2 exists. Consequently, the required unity of invention is not established (PCT Rule 13.1).